

REMARKS

At the time of the Sixth Office Action dated July 29, 2010, claims 10-21 were pending and rejected in this application.

CLAIMS 18-21 ARE REJECTED UNDER 35 U.S.C. § 101

On page 3 of the Sixth Office Action, the Examiner asserted that the claimed invention, as recited in claims 18-21, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

"[C]laim construction ... is an important first step in a § 101 analysis." In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc). The general assumption is that different terms have different meanings. Applied Medical Resources Corp. v. United States Surgical Corp., 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006). Moreover, ignoring a claim term constitutes clear legal error. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971); In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Therefore, the Examiner cannot ignore the term "storage" within the claimed "computer-readable storage medium," and the Examiner must consider the difference between a "computer-readable medium" and a "computer-readable storage medium" when construing the language at issue.

1 The issue of claim construction is discussed in M.P.E.P. § 2111, a portion of which is
2 reproduced below:

3 During patent examination, the pending claims must be "given their broadest reasonable
4 interpretation consistent with the specification." ... The broadest reasonable interpretation of the
5 claims must also be consistent with the interpretation that those skilled in the art would reach. *In*
6 *re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).
7

8 Regarding the broadest reasonable construction standard, reference is also made to M.P.E.P. §
9 2111, which states:

10 During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In*
11 *re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed.
12 Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district
13 courts; during examination the USPTO must give claims their broadest reasonable interpretation
14 in light of the specification. This means that the words of the claim must be given their plain
15 meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319,
16 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-*
17 *Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). (underlined added)
18

19 Regarding the "plain meaning" standard, reference is again made to M.P.E.P. § 2111(III),
20 entitled "'Plain Meaning' refers to the ordinary and customary meaning given to the term by
21 those of ordinary skill in the art," which states:

22 "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have
23 to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the
24 effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75
25 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*).
26

27 Referring to *Phillips v. AWH Corp.*, 415 F.3d, 1303 (Fed. Cir. 2005) (*en banc*), which was cited
28 immediately above, the Federal Circuit stated:

29 In *Texas Digital*, the court noted that "dictionaries, encyclopedias and treatises are
30 particularly useful resources to assist the court in determining the ordinary and customary
31 meanings of claim terms." ... Those texts, the court explained, are "objective resources that serve
32 as reliable sources of information on the established meanings that would have been attributed to
33 the terms of the claims by those of skill in the art," and they "deserve no less fealty in the context
34 of claim construction" than in any other area of law ... The court added that because words often
35 have multiple dictionary meanings, the intrinsic record must be consulted to determine which of
36 the different possible dictionary meanings is most consistent with the use of the term in question
37 by the inventor. If more than one dictionary definition is consistent with the use of the words in

1 the intrinsic record, the court stated, "the claim terms may be construed to encompass all such
2 consistent meanings." (citations omitted)
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4 As evidence of the meaning that the term "storage medium," Applicants refer to the
5 following dictionary definitions:

6 **storage medium** [COMPUT SCI] Any device or recording medium into which data can
7 be copied and held until some later time, and from which the entire original data can be obtained.¹

8 **storage** [COMPUT SCI] Any device that can accept, retain and read back one or more
9 times, the means of storing data may be chemical, electrical magnetic, magnetic, mechanical, or
10 sonic.²
11

12 In the decision of In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995), the Federal Circuit
13 issued a precedential order dismissing an appeal of a rejection of computer product claims³ based
14 upon 35 U.S.C. § 101 because the Patent Office conceded "that computer programs embodied in
15 a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. Sec.
16 101 and must be examined under 35 U.S.C. Secs. 102 and 103." The notion that a storage
17 medium recites statutory subject matter is also supported by a recent Decision for the Board of
18 Patent Appeals and Interferences (hereinafter the Honorable Board). Specifically, reference is
19 made to the non-precedential opinion of Ex parte Mehta (Appeal No. 2008-004853). In
20 reversing a rejection under 35 U.S.C. § 101, the Honorable Board held the following:

21 We agree with Appellants (App. Br. 10-11; Reply Br. 1-3), however, that, contrary to the
22 Examiner's contention, claims 29-42 necessarily include a storage medium since the language of
23 independent claim 29 recites an "article comprising a storage medium...." Further, the language of
24 independent claim 29, which recites that the storage medium stores computer-executable
25 instructions which are readable and cause a computer to perform the listed operations, establishes
26 the requisite structural and functional interrelationships between the computer and the stored

¹ McGraw-Hill Dictionary of Scientific and Technical Terms, 6th Edition, McGraw-Hill Book Company, 2003, pg. 2039.

² McGraw-Hill Dictionary of Scientific and Technical Terms, 6th Edition, McGraw-Hill Book Company, 2003, pg. 2038.

³ The application at issued ultimately issued as U.S. Patent No. 5,710,578, and claim 1 recites "a computer usable medium having computer readable program code means embodied therein" for causing a computer to perform various steps of a method.

instructions which permit the computer's functionality to be realized. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). (emphasis added)

In this regard, the Examiner is directed to M.P.E.P. § 2106.01, which states:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. (emphasis added)

Independent claim 18 recites a "computer-readable storage medium having stored thereon a computer program." Claim 18 also recites that the computer program is used by a machine (i.e., a messaging computer system) to perform various steps of a method. Thus, the use of technology (i.e., a computer-readable storage medium and a messaging computer system) permits the function of the functional descriptive material (i.e., computer program comprising a routine set of instructions) to be realized. Therefore, claim 18 clearly falls within the scope of statutory subject matter described within M.P.E.P. § 2106.01 and at issue within In re Beauregard and Ex parte Mehta.

For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 18-21 under 35 U.S.C. § 101.

CLAIMS 10, 12-14, 16-18, AND 20-21 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KNIGHT ET AL., U.S. PATENT NO. 6,493,703 (HEREINAFTER KNIGHT), IN VIEW OF YEAGER ET AL., U.S. PATENT NO. 6,735,770 (HEREINAFTER YEAGER)

On pages 3-5 of the Sixth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Knight and Yeager. This rejection is respectfully traversed.

1 On October 10, 2007, the Patent Office issued the "Examination Guidelines for
2 Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR*
3 *International Co. v. Teleflex Inc.*," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination
4 Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103."
5 Within this section is the following quote from the Supreme Court: "rejections on obviousness
6 grounds cannot be sustained by merely conclusory statements; instead there must be some
7 articulated reasoning with some rational underpinning to support the legal conclusion of
8 obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*,
9 441 F.3d 977, 988 (Fed. Cir. 2006)).

10
11 Referring to the first column on page 57,529 of the Examination Guidelines for
12 Determining Obviousness, the following is a list of rationales that may be used to support a
13 finding of obviousness under 35 U.S.C. § 103:

14 (A) Combining prior art elements according to known methods to yield
15 predictable results;

16 (B) Simple substitution of one known element for another to obtain
17 predictable results;

18 (C) Use of known technique to improve similar devices (methods, or
19 products) in the same way;

20 (D) Applying a known technique to a known device (method, or product)
21 ready for improvement to yield predictable results;

22 (E) "Obvious to try" - choosing from a finite number of identified,
23 predictable solutions, with a reasonable expectation of success;

24 (F) Known work in one field of endeavor may prompt variations of it for
25 use in either the same field or a different one based on design incentives or other
26 market forces if the variations would have been predictable to one of ordinary
27 skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on pages 4 and 5 of the First Office Action, the Examiner appears to be employing rationale (A). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. Applicants, therefore, request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring to rationale (A), entitled "Combining Prior Art Elements According to Known Methods to Yield Predictable Results," as discussed on page 57,529 of the Examination Guidelines for Determining Obviousness, the following findings of fact must be articulated by the Examiner:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

1 Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of
2 the Examination guidelines, the following was stated:

3 Office personnel fulfill the critical role of factfinder when resolving the
4 *Graham* inquiries. It must be remembered that while the ultimate determination of
5 obviousness is a legal conclusion, the underlying *Graham* inquiries are factual.
6 When making an obviousness rejection, Office personnel must therefore ensure
7 that the written record includes findings of fact concerning the state of the art and
8 the teachings of the references applied. In certain circumstances, it may also be
9 important to include explicit findings as to how a person of ordinary skill would
10 have understood prior art teachings, or what a person of ordinary skill would have
11 known or could have done. Factual findings made by Office personnel are the
12 necessary underpinnings to establish obviousness.

13
14 Decisions of the Patent Office are reviewed in accordance with the standards of the
15 Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the
16 Administrative Procedure Act, 5 U.S.C. '706, to appeals of PTO rulings). Thus the Patent
17 Office's factual findings are reviewed to determine whether they are unsupported by substantial
18 evidence. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means
19 "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept
20 as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

21
22 In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set
23 forth the factual inquiries that are to be applied when establishing a background for determining
24 obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- 25 (A) Determine the scope and content of the prior art;
26 (B) Ascertain the differences between the prior art and the claims at issue;

- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

With regard to an obviousness rejection under 35 U.S.C. § 103, the Board of Patent Appeals and Interferences provided the following guidance within the precedential opinion of Ex parte Frye, (Appeal No. 2009-006013):

The Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope that he seeks – the so-called "*prima facie* case." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the initial burden of proof is on the USPTO "to produce the factual basis for its rejection of an application under sections 102 and 103") (quoting In re Warner, 379 F.2d 1011, 1016 (CCPA 1967)). As the Federal Circuit has observed, "[t]he term '*prima facie* case' refers only to the initial examination step." Oetiker, 977 F.2d at 1445; see also Oetiker, 977 F.2d at 1449 ("The process of patent examination is an interactive one.") (Plager, J., concurring). The "*prima facie* case" serves as a procedural mechanism that shifts the burden of going forward to the applicant, who must produce evidence and/or argument rebutting the case of unpatentability. See Oetiker, 977 F.2d at 1445;

1 Piasecki, 745 F.2d at 1472. Applicant's rebuttal evidence "may relate to any of
2 the *Graham* factors including the so-called secondary considerations." Piasecki,
3 745 F.2d at 1472 (citations omitted). The examiner then determines patentability
4 "on the totality of the record, by a preponderance of the evidence with due
5 consideration to the persuasiveness of argument." Oetiker, 977 F.2d at 1445.
6 (emphasis in original)
7

8 Upon reviewing the Examiner's analysis in view of the requirements discussed above
9 necessary for the Examiner to establish a prima facie case of obviousness, Applicants recognize
10 deficiencies in the Examiner's analysis.
11

12 Knight

13 Referring to the second full paragraph on page 4 of the Sixth Office Action, the Examiner
14 asserted the following:

15 Knight also discloses "retrieving the messages, from within the separates ones of the
16 plurality of subtopics, respectively using the separate retrieval threads of execution for each
17 specific subtopic" as a series of software robots (separate threads) for retrieving content (abstract,
18 col. 5 ln. 45-49, Fig. 4).
19

20 Applicants respectfully submit that the Examiner has mischaracterized the scope and content of
21 Knight.
22

23 For ease of reference, the Examiner cited passage of column 5, lines 45-49 is reproduced
24 below:

25 Yet another related object is to permit a user of an online service to interact with search robots
26 located on an internet server to help formulate, execute and remember search queries of interest to
27 such user.
28

29 Notably absent from this passage is any of the teachings attributed to this passage by the
30 Examiner. As an aside, Applicants note that the Examiner's citation to the "Summary of the

1 Invention" portion of a cited reference is oftentimes of little assistance is aiding Applicants in
2 evaluating the Examiner's analysis. By definition, these passages are generic summaries, and the
3 record would be much clearer if the Examiner actually cited to the "Detailed Description"
4 portion of the cited reference.

5
6 Notwithstanding that the Examiner's cited passage does not support the Examiner's
7 alleged findings of fact, Applicants refer the Examiner to column 10, lines 19-27 of Knight,
8 which is reproduced below:

9 In contrast to community search robots 231, whose efforts result in compilations/indices usable by
10 the community as a whole, customized search robots 232 create logical collections of messages
11 based on individual user filtering criteria. To ensure that the independent functionality provided by
12 customized search robots 232 does not overwhelm server 220, only a limited number of such
13 robots are made available to subscribers. (emphasis added)
14

15 As discussed therein, the customized search robots 232 are based upon an individual user
16 filtering criteria. Thus, the alleged "separate retrieval threads of execution" (i.e., the robots of
17 Knight) are not separated based upon each specific subtopic, as alleged by the Examiner.
18 Instead, they are based upon an individual user filtering criteria. Thus, the Examiner has
19 mischaracterized the scope and content of Knight.

20
21 Additionally, Applicants note that the actually claim language at issue is "retrieving the
22 messages, from within the separates ones of the plurality of subtopics, respectively using the
23 separate retrieval threads of execution for each specific subtopic/subscriber pair" (emphasis
24 added). This underlined portion was not discussed by the Examiner. Moreover, upon reviewing
25 the Examiner's additional analysis regarding Yeager, the Examiner does not address the
26 underlined portion of the claim language. Thus, the Examiner has not even alleged that the
27 applied prior art teaches all of the claimed limitations. On this basis alone, without the need to

1 consider any other argument, the Examiner has failed to establish a prima facie case of
2 obviousness.

3
4 Applicants, therefore, respectfully submit that the Examiner has committed error by
5 improperly determining the scope and content of the prior art, which is one of the Graham
6 factual inquiries. Additionally, since the Examiner has failed to recognize that Knight does not
7 teach all the limitations for which the Examiner is relying upon Knight to teach, the Examiner
8 has also committed error by failing to properly ascertain the differences between the applied
9 prior art and the claims at issue, which is another one of the Graham factual inquiries. Thus, the
10 Examiner has not set forth a proper prima facie case of obviousness.

11
12 Yeager

13 Referring to the last paragraph on page 4 of the Sixth Office Action, the Examiner
14 presented the following analysis.

15 Knight not explicitly disclose "upon determining that the messages exist, for the request
16 topic, within the separate ones of the plurality of subtopics, creating a separate retrieval thread of
17 execution for each specific subtopic" however it does suggest this (especially considering the
18 Board's finding on pg. 9 concerning claim 5) by teaching that a customized robot is invoked upon
19 query (col. 6 ln. 6-10). Nevertheless this is explicitly disclosed by Yeager as initializing a thread
20 for message retrieval (col. 7 ln. 65 — col. 8 ln. 17).
21

22 First, the Examiner is invited to reread the Decision of the Honorable Board.
23 Specifically, the Honorable Board found that Knight taught a "plurality of threads." However,
24 this is considerably different than a finding that Knight suggests "upon determining that the
25 messages exist, for the requested topic, within the separate ones of the plurality of subtopics,
26 creating a separate retrieval thread of execution for each specific subtopic/subscriber pair," as
27 alleged by the Examiner.

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Second, the Examiner's findings with regard to what Knight suggests is simply wrong. The claims recite that the separate retrieval threads of execution are created upon determining that the messages exist within separate ones of the plurality of subtopics – no such determination, however, is taught by Knight. Although the customized robot described by Knight is used to create a "logical collections of messages based on individual user filtering criteria," the Examiner has failed to explain how this corresponds to the claimed "upon determining that the messages exists."

However, assuming arguendo that the creation of the logical collections of messages described by Knight corresponds to the claimed determining that the message exists, the claimed invention recites that "upon determining that the message exists." The use of the word "upon" is this phrase creates a condition precedent for the subsequent phrase. Specifically, a determination that the message exists must precede the subsequent limitations, which includes the creation of the separate retrieval thread. However, the search robots of Knight already exist, since the robots determines whether or not a message exists – assuming that the creation of the logical collections of messages described by Knight corresponds to the claimed determining that the message exists. Therefore, Knight cannot teach or suggest the limitations at issue. Moreover, Knight is silent as to separate retrieval threads of execution for specific subtopic/subscriber pairs.

The Examiner's sole analysis regarding Yeager is to cite column 7, lines 65 through column 8, line 17 while asserting "this is explicitly disclosed by Yeager as initializing a thread

for message retrieval." For ease of reference, the Examiner's cited passage from Yeager is reproduced below:

At step 208 a selected child process initializes a thread for managing the accepted connection. The accepted connection is managed based on the protocol being used by the client, e.g. IMAP or POP. In the described embodiment, each child process has an initialization thread to initialize new active connection threads. In other preferred embodiments, new active connection threads can be initialized outside the child process. At step 210 the selected child process and thread manage the client request. Examples of a thread managing a client request such as copying a message or retrieving a message, are discussed in detail below. At this stage, a master-slave relationship is created between the newly created thread (slave) for the client (master). When the client terminates the connection or times-out from being idle for a predetermined time, the parent process begins thread clean-up at step 212. At thread clean-up and exit, all resources associated with the thread are made available for other threads. After thread clean-up, the message access procedure for a client is complete.

Although this passage refers to initializing a thread, the Examiner's cited passage is silent as to the claimed "a separate retrieval thread of execution" that is created "upon determining that the messages exist."

The teachings regarding step 208 refer to the initialization of a thread for managing an accepted connection. However, of the claim limitations that the Examiner is relying upon Yeager to teach, these teachings regarding step 208 merely refer to "creating a ... thread." Step 210 of Yeager describes the managing of a thread whereby the thread is managed by a client. Step 212 then describes thread clean-up. Thus, notably absent from the Examiner cited passages is almost all of the limitations at issue (i.e., "upon determining that the messages exist, for the requested topic, within the separate ones of the plurality of subtopics, creating a separate retrieval thread of execution for each specific subtopic/subscriber pair").

Applicants, therefore, respectfully submit that the Examiner has committed error by improperly determining the scope and content of the prior art, which is one of the Graham

1 factual inquiries. Additionally, since the Examiner has failed to recognize that Yeager does not
2 teach all the limitations for which the Examiner is relying upon Yeager to teach, the Examiner
3 has also committed error by failing to properly ascertain the differences between the applied
4 prior art and the claims at issue, which is another one of the Graham factual inquiries. Thus, the
5 Examiner has not set forth a proper prima facie case of obviousness.

6
7 Obviousness Analysis

8 Referring to the paragraph spanning pages 4 and 5 of the Sixth Office Action, the
9 Examiner presented the following obviousness analysis.

10 It would have been obvious to one of ordinary skill in the art at the time of the invention
11 to modify Knight with the thread initialization taught by Yeager for the purpose of processing
12 requests. It is well known in the art to use multiple threads to handle requests (as evidenced by
13 both Knight and Yeager). Therefore, this is merely the combination of known elements according
14 to their established function in order to yield a predictable result.
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16 As noted above, the Examiner appears to be employing rationale (A), entitled "Combining
17 Prior Art Elements According to Known Methods to Yield Predictable Results." In so doing, the
18 Examination Guidelines for Determining Obviousness states that the following findings of fact
19 must be articulated by the Examiner:

20 (1) a finding that the prior art included each element claimed, although not
21 necessarily in a single prior art reference, with the only difference between the
22 claimed invention and the prior art being the lack of actual combination of the
23 elements in a single prior art reference;

24 (2) a finding that one of ordinary skill in the art could have combined the
25 elements as claimed by known methods, and that in combination, each element
26 merely would have performed the same function as it did separately;

27 (3) a finding that one of ordinary skill in the art would have recognized
28 that the results of the combination were predictable; and

1 (4) whatever additional findings based on the Graham factual inquiries
2 may be necessary, in view of the facts of the case under consideration, to explain
3 a conclusion of obviousness.
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5 Referring to finding (1), the Examiner has failed to establish that the prior art includes
6 each element with the only difference between the claimed invention and the prior art being the
7 lack of actual combination of the elements in a single prior art reference. Referring to finding
8 (2), the Examiner has failed to identify how one of ordinary skill in the art would have combined
9 the elements or the known method that would be employed to combine these elements.
10 Moreover, the Examiner has failed to present any evidence that each element would have
11 performed the same function as it did separately. Referring to finding (3), the Examiner has
12 failed to present any substantial evidence that one of ordinary skill in the art would have (i)
13 known the results of the combination and (ii) recognized that the results of the combination were
14 predictable. Applicants have already addressed finding (4) above.
15

16 Instead, the Examiner's sole assertion was that it would have been obvious to modify
17 Knight in view of Yeager "for the purpose of processing requests." However, Knight already
18 teaches the processing of requests (see, e.g., column 11, lines 48-51). As such, since Knight
19 already teaches the processing of requests, the Examiner has failed to identify any particular
20 benefit that would result from the proposed combination of Knight and Yeager. As stated by the
21 Supreme Court, "rejections on obviousness grounds cannot be sustained by merely conclusory
22 statements; instead there must be some articulated reasoning with some rational underpinning to
23 support the legal conclusion of obviousness." The Examiner's analysis has not articulated a
24 reasoning with some rational underpinning. Instead, the Examiner's reasoning appears to be an

1 assertion that since both references deal with the handling of requests, then it would have been
2 obvious to combine these references. This rationale, however, would apply to almost every
3 reference in the field and, thus, is overbroad.

4
5 For the above-described reasons, the Examiner has failed to establish that the claimed
6 invention, as recited in claims 10, 12-14, 16-18, and 20-21, would have been obvious within the
7 meaning of 35 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed
8 rejection of claims 10, 12-14, 16-18, and 20-21 under 35 U.S.C. § 103 for obviousness based upon
9 Knight and Yeager.

10
11 **CLAIMS 11, 15, AND 19 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED**
12 **UPON KNIGHT IN VIEW OF YEAGER AND RAZDAN ET AL., U.S. PATENT PUBLICATION NO.**
13 **2002/0141584 (HEREINAFTER RAZDAN)**

14 On pages 5 and 6 of the Sixth Office Action, the Examiner concluded that one having
15 ordinary skill in the art would have considered the claimed invention to be obvious in view of
16 Knight, Yeager, and Razdan. This rejection is respectfully traversed.

17
18 Claims 11, 15, and 19 respectively depend from independent claims 10, 14, and 18, and
19 Applicants incorporate herein the arguments previously advanced in traversing the imposed
20 rejection of claims 10, 14, and 18 under 35 U.S.C. § 103 for obviousness based upon Knight and
21 Yeager. The tertiary reference to Razdan does not cure the argued deficiencies of the combination
22 of Knight and Yeager. Accordingly, even if one having ordinary skill in the art did modify Knight
23 in view of Yeager and Razdan, the proposed combination of references would not yield the claimed

1 invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 11, 15,
2 and 19 under 35 U.S.C. § 103 for obviousness based upon Knight in view of Yeager and Razdan
3 is not viable, and hence, Applicants solicit withdrawal thereof.

4

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: October 29, 2010

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